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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,901	07/19/2000	Michael J. Botich	1032-P00101US9	2085

110 7590 06/04/2003

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EXAMINER

SERKE, CATHERINE

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/619,901

Applicant(s)

BOTICH ET AL.

Examiner

Catherine Serke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 45-46, 48-49, 51-52, 54-55, 57-59, 61-62 and 69-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (US Pat# 5,632,733) in view of Alberts et al (US Pat# 4,906,236).

Shaw discloses a hollow barrel, a needle assembly with a needle and a biasing element, and a plunger with a cavity. See figure 1-3. The device further includes a needle retainer (30). The functional language can be seen in the specification and through the drawings. In the retracted position the needle is contained within the cavity. See figure 3.

Shaw meets the claims limitations as described above but fails to include a connector with two complimentary threads. However, Alberts discloses a hypodermic needle with a syringe barrel and a needle assembly connected by a threaded connector to the proximal end of the syringe barrel.

At the time of the invention, it would have been obvious to incorporate the connector as taught by Alberts into the invention of Shaw. Both devices are analogous in the art (syringes) and therefore a combination is proper. Additionally, the motivation for the incorporation would have been in order to enhance the usability of the syringe with a variety of needle sizes to attach immediately before use.

Claims 47,53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Alberts et al in further view of Allard.

Shaw in view of Alberts meets the claim limitations as described above but fails to include retaining fingers. However, Allard discloses a retractable needle syringe that includes a finger mechanism to retain the needle in the projected position.

At the time of the invention, it would have been obvious to incorporate the finger mechanism as taught by Allard into the invention of Shaw in view of Alberts. Both inventions disclose retractable needle syringes, are analogous in the art and therefore a combination is proper. Additionally, the instant application provides no criticality for the finger mechanism performing better than other retaining mechanisms. Thus, the motivation for the combination would have been in order to enhance the frictional retention of the needle in place.

Claims 50,56,60 and 63-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Alberts et al in further view of Ridderheim et al (US Pat# 4,955,870).

Shaw in view of Alberts meets the claim limitations as described above but fails to include the cover being severed from the plunger. However, Ridderheim discloses a plunger with a severable proximal cover.

At the time of the invention, it would have been obvious to incorporate the teaching of the severable cover into the invention of Shaw in view of Alberts. Both inventions are analogous in the art and therefore a combination is proper. Additionally, the motivation for the

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incorporation would have been to enhance the frictional placement of the cover to prevent accidental retraction of the needle during use.

Response to Arguments

Applicant's arguments with respect to claims 45-73 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Serke whose telephone number is 703-308-4846. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2192.

Catherine Serke *CS*,
June 2, 2003


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700